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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,432	03/02/2004	Juergen Benz	588.1016	5411
23280	7590	01/09/2006	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			LE, DAVID D	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/791,432	BENZ ET AL.	
	Examiner David D. Le	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 October 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/17/05</u> .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. This is the second Office action on the merits of Application No. 10/791,432, filed on 02 March 2004. Claims 1-19 are pending.

### **Documents**

2. The following documents have been received and filed as part of the patent application:

- Foreign Priority Document, received on 03/02/04
- Declaration and Power of Attorney, received on 04/23/04
- Information Disclosure Statement, received on 10/17/05

### ***Oath/Declaration***

3. The oath or declaration, filed on 23 April 2004, is defective because the specification to which the oath or declaration is directed has not been properly identified. The present declaration, filed on 23 April 2004, indicates that the specification of which is attached hereto, which is inaccurate. Accordingly, a new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02 i.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent No. 6,878,095 to Shigyo.**

***Claims 1-19:***

Shigyo (Figs. 1-5; column 2, line 21 – column 7, line 4) discloses an automatic-clutch control system of a transmission for a vehicle comprising:

- A drive motor (i.e., column 2, lines 41-42, being the internal combustion engine);
- A manual/automatic transmission (i.e., Fig. 1 and column 4, lines 30-33);
- An automatic clutch (i.e., Fig. 1, element 4) connecting the drive motor and the manual/automatic transmission (i.e., Fig. 1);
- A controller (i.e., Fig. 1, element 31) capable of automatically controlling the manual/automatic transmission;
- Wherein the controller is capable of automatically changing the engine braking mode to a free-wheeling mode (i.e., column 5, line 31 – column 6, line 17);
- Wherein the manual/automatic transmission is a motor vehicle transmission or drive train;

- Wherein the controller is controlling the automatic clutch so as to change from the engine braking mode to a free-wheeling mode (i.e., column 5, line 31 – column 6, line 17);
- Wherein the automatic clutch is disengaged to implement the free-wheeling mode (i.e., column 5, line 62 – column 6, line 6);
- Wherein the automatic clutch is disengaged to implement the free-wheeling mode when a transmission gear is equal to a maximum free-wheeling gear (i.e., column 6, lines 4-6);
- Wherein the automatic clutch is disengaged to implement the free-wheeling mode when a gas pedal has not been operated (i.e., column 5, lines 5-12);
- Wherein the automatic clutch is disengaged to implement the free-wheeling mode when an idling switch is activated (i.e., column 5, lines 5-7);
- Wherein the automatic clutch is disengaged to implement the free-wheeling mode when a driver's desired torque is less than zero (i.e., column 5, line 62 – column 6, line 6);
- Wherein the clutch is disengaged to implement the free-wheeling mode when a driving speed is less than the maximum free-wheeling speed (i.e., column 6, lines 7-17);
- Wherein the automatic clutch is disengaged to implement the free-wheeling mode when no downhill/coasting driving is detected (i.e., column 5, lines 5-11);

- Wherein the automatic clutch is disengaged to implement the free-wheeling mode when the manual/automatic transmission is shifted to an automatic driving program (i.e., column 4, line 66 – column 5, line 3);
- Wherein the automatic clutch is disengaged to implement the free-wheeling mode when a creep function is not activated (Shigyo'095 inherently discloses this limitation because it would be impossible to activate the “creep function” when the automatic clutch is completely disengaged);
- Wherein the automatic clutch is disengaged to implement the free-wheeling mode when there is no block of the free-wheeling function (i.e., column 5, line 31 – column 6, line 17; it appears that there is no block in implementing the free-wheeling mode);
- Wherein the change to the free-wheeling mode is blocked when a driving speed is greater than the maximum free-wheeling speed (i.e., column 5, line 37-44, when step S8 is negative and the routine proceeds to step S7);
- Wherein the change to the free-wheeling mode is blocked when no automatic driving program has been activated (i.e., column 4, line 66 – column 5, line 4, when step S2 is negative and the routine proceeds to step S7);
- Wherein the change to the free-wheeling mode is blocked when a hill driving program has been activated (i.e., column 5, lines 5-12, when step S3 is negative and the routine proceeds to step S7);

- Wherein a block of the change to the free-wheeling mode is inherently deactivated when a gas pedal is operated (i.e., column 5, lines 5-12, when step S3 is negative and the routine proceeds to step S7);
- Wherein a block of the change to the free-wheeling mode is inherently deactivated when there is a change from a manual driving program to an automatic driving program (i.e., column 4, line 66 – column 5, line 4); and
- Wherein a block of the change to the free-wheeling mode is inherently deactivated when there is a change in gear with that is less than or equal to a maximum free-wheeling gear (i.e., column 4, lines 45-63).

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0700-1530).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*DDL*  
ddl

*Charles A. Marmor 1/5/06*  
**CHARLES A. MARMOR**  
**SUPERVISORY PATENT EXAMINER**  
**ART UNIT 3681**